

-8-

REMARKS

The Examiner has further rejected Claims 1-36 under 35 U.S.C. 102(e) as being anticipated by Maloney (U.S. Pat. No.: 6,549,208). Applicant respectfully disagrees with such rejection, especially in view of the amendments made hereinabove. Specifically, applicant has amended each of the independent claims to include the subject matter (or substantially similar, but not identical subject matter) of Claim 11 et al.

In the Examiner's action, the Examiner relies on the following excerpt from Maloney to meet applicant's claimed "prior to the certain electronic file being made available for viewing by the intended recipient, converting the certain electronic file to a second file format that is different from the first file format and that prevents the computer virus from executing when the converted electronic file is opened by the intended recipient."

"Data in the knowledge base 16 is made available to a data parsing tool 18 that converts the captured network data from the discovery tool 12 to a form useable by downstream programs of the system. Data accessed by the parsing tool 18 is then available to analytical engine 20 for analyzing the data captured by the discovery tool 12 and supports the merging of several data files and the development and comparison of network usage patterns." (see col. 4, lines 39-42)

Applicant respectfully disagrees with this assertion. In particular, the foregoing excerpt merely suggests the conversion of captured network data for use by downstream programs. More specifically, Maloney discloses converting data to vector-based nodal diagrams for review by an administrator. The data that is in route to the "intended recipient" is not converted in the claimed manner.

In sharp contrast, applicant teaches and claims converting the certain electronic file to a second file format that is different from the first file format and that prevents the computer virus from executing when the converted electronic file is opened by the intended recipient. Only applicant teaches and claims such a specific conversion that meets the particular functionality of

-9-

preventing the computer virus from executing when the converted electronic file is opened by the intended recipient.

The Examiner is reminded that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, the identical invention must be shown in as complete detail as contained in the claim. *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

This criterion has simply not been met by the Maloney reference, for the reasons noted above. Nevertheless, despite the foregoing paramount difference and in the spirit of expediting the prosecution of the present application, applicant has amended each of the independent claims to include the following subject matter (or substantially similar, but not identical subject matter) of Claim 11 et al.:

"wherein it is determined whether the certain electronic file represents a potential risk to security of a computer system, said converting the certain electronic file being in response to a determination that the certain electronic file represents the potential risk to the security of the computer system."

The Examiner relies on the following excerpt from Maloney to meet the foregoing claimed subject matter requiring "said converting the certain electronic file being in response to a determination that the certain electronic file represents the potential risk to the security of the computer system."

"With the information revealed by the system of the present invention, Security Administrators can identify potential traffic bottlenecks, locate the existence of backdoors, reduce bandwidth usage, develop profiles of users, and pinpoint illicit activity." (see col. 2, lines 2-3)

'Collection of this data on internets enables virtual intranet diagrams thereby permitting real time analysis of how the network is being used, who is communicating with whom, determination of potential choke points and vulnerabilities, limited "trace route" reconstruction and types of worldwide web service requested.' (see col. 6, line 33)

-10-

"Following parsing of the knowledge base 16 the analytical engine 20 responds to the data for preparation and converting into vector-based nodal diagrams." (see col. 6, lines 66-67)

"Typically the analytical engine 20 creates associations between a number of different charts to determine if such data charts correlate or differentiate." (see col. 7, lines 1-4)

After carefully reviewing such excerpts and the remaining Maloney reference, however, it is clear that Maloney's teachings simply fail to rise to the specificity of applicant's claimed conversion of the certain electronic file being in response to a determination that the certain electronic file represents the potential risk to the security of the computer system. Only applicant teaches and claim, in combination with the remaining claimed features, a technique for providing the aforementioned conversion under a particular condition, namely if the certain electronic file is determined to be infected.

It is noted that there are no relevant conditions suggested by Maloney regarding whether or not Maloney's conversion takes place. In fact, it appears that Maloney *teaches away* from such claimed feature by suggesting conversion of all incoming data prior to analysis so that, *thereafter*, the converted data may be reviewed to determine whether the incoming data is, in fact, infected. In quite an opposite manner, however, applicant teaches and claims determining whether a file is infected *prior* to conversion, such that conversion is conditioned upon such determination.

A notice of allowance or a specific prior art showing of all of applicant's claim limitations, in combination with the remaining claim elements, is respectfully requested.

With respect to the dependent claims, applicant has carefully reviewed the excerpts relied upon by the Examiner to reject the same, and has found serious deficiencies in the Examiner's application of the prior art.

Just by way of example, the Examiner relies on the following excerpt from Maloney to meet applicant's claimed "receiving a second electronic file intended for delivery from another sender to another intended recipient, the second electronic file having a third file format and containing another computer virus; and prior to the second electronic file being made available

-11-

for viewing by the another intended recipient, converting the second electronic file to a fourth file format that is different from the third file format and that prevents the another computer virus from executing when the converted second electronic file is opened by the another intended recipient." (see Claim 14 et al.).

"A second analytical engine 20 from the Department of Defense called PROPELLER is also available." (see col. 4, line 49)

"The addition of a third vector permits the simultaneous viewing of large complex diagrams on interconnected planes in accordance with user instructions from the input device 94. The display of FIG. 5 permits an analyst to rotate the diagram on any axis thereby viewing relationships that otherwise become obscure viewed on two-dimensional planes." (see col. 11, lines 36-41)

"In this example the analysis system 10 as running on the terminal 70 monitors the level of intranet traffic and records packets of data from each of the terminals of the various nodes. For a terminal under attack, such as terminal 64a, the analysis system establishes a target source packet structure and by means of the analytical engine 20 of the present invention could be modified to shut down a target under attack." (see col. 12, lines 16-24)

After carefully reviewing such excerpts and the remaining Maloney reference, however, it is clear that Maloney merely suggests a single "link chart" format. This simply fails to rise to the specificity of applicant's claimed conversion of a first format to a second format, and a third format to a fourth format.

Still yet, the Examiner relies on the following excerpt from Maloney to meet applicant's claimed "wherein the second file format being the HTML file format without scripts" (see Claim 17 et al.).

"The web extraction tool of a knowledge base tool set 96 facilitates the parsing and formatting of data from HTML flat files that are then imported to a database or to the analytical engines 20." (see col. 10, lines 24-25)

Such excerpt and the remaining Maloney reference, however, merely suggest conversion from a HTML file format. There is simply not even a suggestion of any sort of conversion to a second file format being HTML file format without scripts.

-12-

Even still, the Examiner relies on col. 10, lines 30-32; col. 6, lines 52-53; and col. 10, lines 30-33 from Maloney to meet applicant's claimed "determining if the first file format is one of a word processing file format type and a graphics file format type, the second file format being at least one of a TXT file format, a RTF file format without embedded objects, and a HTML file format without scripts if it is determined that the certain file format is the word processing file format type, the second file format being at least one of a JPB file format, a BMP file format, a GIF file format, a HTML file format without scripts, and a JPEG file format if it is determined that the first file format is the graphics file format type" (see Claim 22 et al.).

Applicant respectfully disagrees with this assertion. After carefully reviewing such excerpts and the remaining Maloney reference, it is clear that Maloney does not even suggest the following claimed conversion mapping:

word processing file format type → a TXT file format, a RTF file format without embedded objects, or a HTML file format without scripts; and

graphics file format type → a JPB file format, a BMP file format, a GIF file format, a HTML file format without scripts, or a JPEG file format.

Again notice of allowance or a specific prior art showing of all of applicant's claim limitations, in combination with the remaining claim elements, is respectfully requested.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 971-2573. For payment of any additional fees

-13-

due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1351 (Order No. NAI1P092/01.050.01).

Respectfully submitted,

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